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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,163	11/16/2001	Michael M. Oberberger	IGT1P035X1/P-311CIP	8483
22434	7590	06/23/2004	EXAMINER	
BEYER WEAVER & THOMAS LLP			ASHBURN, STEVEN L	
P.O. BOX 778			ART UNIT	
BERKELEY, CA 94704-0778			PAPER NUMBER	
			3714	

DATE MAILED: 06/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/993,163

Applicant(s)

OBERBERGER ET AL.

Examiner

Steven Ashburn

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/8/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Double Patenting***

The terminal disclaimer filed on April 8, 2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. 6,394,907 has been reviewed and is accepted. The terminal disclaimer has been recorded. The nonstatutory double patenting rejection of claims 1-65 is withdrawn.

### ***Claim Rejections - 35 USC § 102***

**Claims 1, 9-13 and 32-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Klayh, U.S. 2003/0050831 A1.**

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

### ***Claim Rejections - 35 USC § 103***

**Claims 2-8, 14-20, 28 and 35-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klayh in view of Schneier B., "Applied Cryptography, Second Ed.", 1996, Applied Cryptography, Protocols, Algorithms and Source Code in C.**

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

**Claims 21-27, 29-31 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klayh in view of Schneier, as applied to claim 15 above, in further view of Fox et al., U.S. Patent 6,560,581 B1 (May 6, 2003).**

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

**Claims 50-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Klayh* in view of *Schneier*, as applied to claim 15 above, in further view of Gennaro et al., U.S. Patent 5,937,066 (Aug. 10, 1999).**

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

**Claims 55-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Klayh* in view of *Schneier* and *Fox*, as applied to claim 21 above, in further view of Gennaro et al., U.S. Patent 5,937,066 (Aug. 10, 1999).**

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

### ***Response to Arguments***

Applicant's arguments filed April 8, 2004 have been fully considered but they are not persuasive. The examiner's response to each argument is provided below.

The applicant argues that claims 1-65 distinguish over the prior art because Klayh does not disclose a cashless instruments that stores any information obtainable with the card. The examiner respectfully disagrees. First, the feature upon which applicant relies is not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Second, the applicant's argument relies entirely on assumptions of how data cards typically operate. The method described by the applicant is only one of many possible methods of operation. No evidence is offered to show that Klayh necessarily operates in the manner asserted.

Furthermore, the applicant argues that the claimed invention distinguishes over the prior art because Klayh does not disclose cashless instruments that are not associated with a particular player and/or account associated with a player. The examiner respectfully disagrees. This feature, upon which applicant relies, is not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Still furthermore, the applicant argues that the claimed invention distinguishes over the prior art because Klayh does not disclose validation of an ID card. The examiner respectfully disagrees. First, this feature upon which applicant relies is not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Second, Klayh describes validation of PIN associated with a data card. See ¶¶ 41, 62, 63. This constitutes validation of an ID card.

Consequently, for the reasons given above, the rejection of claims 1-65 is respectfully maintained.

#### ***Prior Art Not Relied On***

The following prior art of record is not relied upon but is considered pertinent to applicant's disclosure:

- a. EP 09333717-A2 discloses a multi-site customer loyalty system having points stored on a smart card.
- b. US 2001/0032878 discloses a anonymous cashless system that stores user's financial data on smart cards.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 703 305 3543. The examiner can normally be reached on Monday thru Friday, 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, Primary Examiner Jessica Harrison can be reached on 703-308-2217. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

s.a.



MARK SAGER  
PRIMARY EXAMINER